

REMARKS

The Office Action mailed on January 12, 2004, made final, has been carefully considered and the Examiner's remarks are appreciated. Claims 2, 3, and 16 have been canceled (claim 3 from a previous amendment). Claims 1, 4, 5, 7, 9, and 10 have been currently amended, with claims 4, 5, 7, and 9 amended only to renumber claim dependency. Claims 6, 8, 11-15, and 17-21 are original or were previously presented. And claims 22-35 are new. Therefore claims 1, 4-15, and 17-35 are presented for examination. Applicants respectfully request reconsideration in view of the amendments and the following remarks.

Discussion of the Objections to Claims 18 and 20

The Examiner objected to claims 18 and 20 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

Applicants have adopted the Examiner's suggestion, and have rewritten claims 18 and 20 as new independent claims 22 and 29, respectively. However, claims 18 and 20 themselves have not been rewritten pending further prosecution on the underlying base claim and/or underlying intervening claims. Please note that new claims 23-28 correspond to claims 11-15 and 17, and new claims 30-35 correspond to claims 4-9.

Discussion of the Rejections Under 35 USC §103(a)

The Examiner rejected claims 1, 4-13, and 15-17 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,164,144 to Berg in view of U.S. Patent 6,042,787 to Pawliszyn,

(hereinafter "Pawliszyn-787"). And claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berg in view of Pawliszyn-787, and further in view of U.S. Patent 6,481,301 to Pawliszyn. And claims 19 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berg in view of Pawliszyn-787, and further in view of U.S. Patent 5,693,228 to Koehler et al, (hereinafter "Koehler").

Applicants have since amended independent claims 1 and 10 to clarify the distinctions between the present invention and the prior art. In particular, claim 1 has been amended to include the language,

"wherein said porous sheath comprises a tube movably mounted in said needle so as to be extendable therefrom and allow access to said active extraction media through said perforations, and retractable thereinto to cover said perforations with the needle."

And claim 10 contains similar language. Support for the above limitation is provided on page 2, paragraph 7; page 4, paragraph 16; and page 6, paragraph 20.

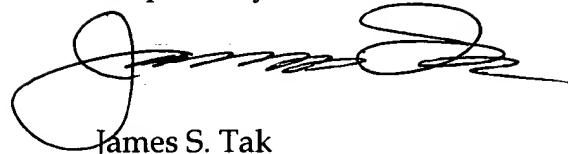
It is respectfully submitted that said amendments render the Examiner's aforementioned rejections moot. Assuming arguendo that the perforations 110 of Pawliszyn-787 are combinable on the needle 24 of Berg, as stated by the Examiner as involving routine skill in the art, nothing in the Berg or Pawliszyn-787 references or any of the other cited prior art references provide any teaching or suggestion that the perforated tube itself be retractable into and extendable from a needle such that the needle provides a covering over the perforations during non-use. While the Berg reference does not teach any manner of retraction, the Pawliszyn-787 reference teaches a coated fiber 80 extendable into and retractable out of the perforated shield 108 shown in Figure 14. There is, however, no

actuation of the perforated shield itself, since the coated fiber is independently retractable into a cavity 70 and the perforated tube does not serve to contain the active extraction media all the time. The CAFC in Standard Oil Co. v. American Cyanmic Co. (227 USPQ 293, 297) stated, “*A person of ordinary skill in the art is also presumed to be one who thinks along the lines of conventional wisdom in the art and is not one who undertakes to innovate...*” Given the motivation in the art to protect the active extraction media, as noted by the Examiner, and the protection provided within the cavity 70 of the Pawliszyn-787 reference independent of the shield, it is respectfully submitted that conventional wisdom would not call for a further covering of the perforations, for the sake of efficiency and simplicity of design. Suggestions to the contrary would be hindsight. For the aforementioned reasons, it is respectfully submitted that independent claims 1 and 10 are allowable as amended, as well as claims 4-9, 11-17, 19, and 21 as dependent claims.

Summary

Applicants therefore respectfully submit that claims 1, 4-15, and 17-35 are in condition for allowance, and request allowance of claims 1, 4-15, and 17-35. In the event that the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, he is respectfully requested to initiate the same with the undersigned at (925) 422-7274.

Respectfully submitted,



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